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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,950	12/27/2000	Richard C. Zorn	263-2290	3169
7590	10/12/2005		EXAMINER MYHRE, JAMES W	
Mark Hanley Grossman & Flight LLC Suite 4220 20 North Wacker Drive Chicago, IL 60606			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/747,950

Applicant(s)

ZORN, RICHARD C.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on August 1, 2005 has been considered but is ineffective to overcome the DeBruin-Ashton (6,014,629) and Manley et al (5,186,443) references. The amendment did not add or delete any claims but amended Claims 1, 5, and 9-11. The currently pending claims considered below remain Claims 1-11.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629).

Claim 1: DeBruin-Ashton discloses a method for targeting promotions to subscribers, comprising:

- a. Creating a brochure template with variable print fields (col 9, line 66 – col 10, line 67);
- b. Accessing a subscriber database and sorting subscribers to create a sub-list of subscribers based on sorting criteria (col 7, lines 1-15 and col 9, lines 24-27).

c. Printing a personalized brochure for each subscriber using the brochure template (col 13, lines 39-47); and

d. Attaching and sending each of the printed brochures to the appropriate corresponding subscriber (col 13, lines 39-47).

The Examiner notes that DeBruin-Ashton's sorting of the subscribers based on whether or not the subscriber wears eyeglasses is the equivalent of claimed creation of two sub-lists of subscribers.

While DeBruin-Ashton does not explicitly disclose generating a second brochure template, it is disclosed that once the designer has created the brochure template it is stored in a template directory 124 and then used to print personalized directories (col 9, line 66 – col 10, line 14; col 10, lines 36-67; and col 11, lines 5-7). It is also disclosed that the template includes various fields that contain fixed images, fixed text, and variable print fields that have been "blocked-out" for inclusion of variable information such as customer's name, address, listing of physicians, map, discount coupons, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made that more than one template could be created (generated) and stored in the template directory 124. One would have been motivated to generate and store more than one template in DeBruin-Ashton in view of its disclosure of generating lists of various types of medical professionals (doctors, dentists, health care providers, etc.), each of which would have varying fields of information as discussed during the interview conducted with the Applicant on March 8, 2005. For example, a directory of veterinarians may require a field for identifying the types of animals that can be treated,

and a directory of surgeons may require a field identifying the hospital or hospitals to which the surgeon is associated. Whereas, a directory of dentists may not require either of these fields. While it is possible to use a single template and just leave blank columns where these fields would have been printed on the other directories, it would have been obvious and much more effective to set up several templates configured for each of the exemplary directories and to use the appropriate template when generating the directory.

While DeBruin-Ashton discloses merging the directory and the other personalized data (e.g. advertisements or coupons) and printing the combined data as a brochure, it is not explicitly disclosed that the brochure is attached to a periodical (e.g. magazine or newspaper) being sent to the user. Official Notice is taken that it is old and well known to attach or otherwise package a plurality of documents together (i.e. collate) prior to sending to a recipient. For example, the Reader's Digest™ magazine arriving at a subscriber's location includes not only the actual book, but also numerous cards, brochures, etc. inserted or otherwise attached to the book. Manley et al (5,186,443) and Mayer et al (5,287,976)(previously presented) disclose a machine and method for performing such collation to insert different various printed documents (based on the subscriber's profile) into a newspaper, bind the bundle, and deliver the bundle to the targeted subscriber. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the brochure generated in DeBruin-Ashton to a periodical or other document being sent to the subscriber. One would have been motivated to attach the brochure to the periodical in

order to reduce the amount of postage required for large mailings (by taking advantage of bulk mailing rates of the Post Office) as discussed in Manley and Mayer.

Claim 2: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 1 above, and further discloses the sorting criteria relates to a characteristic of the subscribers, such as a previous relationship with a particular physician, wearing eyeglasses, living within a certain region, etc. (col 7, lines 1-15 and col 9, lines 24-27).

Claim 4: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 1 above, and further discloses that at least 25% of the brochures include editorial and/or public service information (Figure 3B, items 340). The Examiner notes that the type of information printed on the brochure does not affect the method steps on customizing the brochure and, thus, is given little if any patentable weight. However, DeBruin-Ashton's lists of health care providers within the vicinity of the subscribers is considered to be public service information and is shown to cover the majority of the printed page in the brochure.

Claims 5 and 9: DeBruin-Ashton discloses a method for targeting promotions to subscribers, comprising:

- a. Accessing a subscriber database and sorting subscribers to create a plurality of sub-lists of subscribers based on sorting criteria (col 7, lines 1-15 and col 9, lines 24-27).
- c. Printing a personalized brochure for each subscriber in each respective sub-list (col 13, lines 39-47); and
- d. Attaching and sending each of the printed brochures to the appropriate corresponding subscriber (col 13, lines 39-47).

The Examiner notes that DeBruin-Ashton's sorting of the subscribers based on whether or not the subscriber wears eyeglasses is the equivalent of claimed creation of two sub-lists of subscribers.

While DeBruin-Ashton discloses merging the directory and the other personalized data (e.g. advertisements or coupons) and printing the combined data as a brochure, it is not explicitly disclosed that the brochure is attached to a periodical (e.g. magazine or newspaper) being sent to the user. Official Notice is taken that it is old and well known to attach or otherwise package a plurality of documents together (i.e. collate) prior to sending to a recipient. For example, the Reader's Digest™ magazine arriving at a subscriber's location includes not only the actual book, but also numerous cards, brochures, etc. inserted or otherwise attached to the book. Manley et al (5,186,443)(previously presented) discloses a machine and method for performing such collation to insert different various printed documents (based on the subscriber's profile)

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into a newspaper, bind the bundle, and deliver the bundle to the targeted subscriber.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the brochure generated in DeBruin-Ashton to a periodical or other document being sent to the subscriber. One would have been motivated to attach the brochure to the periodical in order to reduce the amount of postage required for large mailings (by taking advantage of bulk mailing rates of the Post Office) as discussed in Manley.

Claims 6 and 10: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claims 5 and 9 above, and further discloses the sorting criteria relates to a characteristic of the subscribers, such as a previous relationship with a particular physician, wearing eyeglasses, living within a certain region, etc. (col 7, lines 1-15 and col 9, lines 24-27).

Claim 8: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 5 above, and further discloses that at least 25% of the brochures include editorial and/or public service information (Figure 3B, items 340). The Examiner notes that the type of information printed on the brochure does not affect the method steps on customizing the brochure and, thus, is given little if any patentable weight. However, DeBruin-Ashton's lists of health care providers within the vicinity of the subscribers is considered to be public service information and is shown to cover the majority of the printed page in the brochure.



Claim 11: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 10 above, and further discloses including a coupon in the printed version of the brochure (Figure 3B, items 346 and col 9, lines 18-27). DeBruin-Ashton further discloses that the coupon is selected and printed based on the personal criteria of the subscriber, i.e. the coupons for a discount on optical services or products shown in Figure 3B are only printed in the brochures being sent to subscribers who wear eyeglasses.

4. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Manley et al (5,186,443).

Claims 3 and 7: DeBruin-Ashley discloses a method for targeting promotions to subscribers as in Claims 2 and 6 above, and further discloses that the sorting criteria relates to a characteristic of the subscriber. However, it is not explicitly disclosed that the characteristic relates to the subscriber's fiscal credit. Manley discloses a similar method for sending personalized printed material to subscribers, and further discloses that the personalization and sorting are based on the subscriber's fiscal credit, i.e. the possession of a particular credit card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the subscriber's fiscal credit as at least one of the sorting criteria being used by DeBruin-Ashton. One would have been motivated to use this type of criteria in DeBruin-Ashton in order to select physicians which the subscriber can afford, e.g. one who accepts the health insurance held by the subscriber.

### ***Response to Arguments***

5. Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive.

The Applicant's arguments against the 35 U.S.C. 102 rejection of claims 5, 6, and 8-11 are rendered moot by the new rejection above.

The Applicant arguments against the 35 U.S.C 103 rejection of the remaining claims have been addressed at length in the expanded rejection above.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM

October 5, 2005



James W. Myhre

Primary Examiner

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